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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,859	06/14/2006	Masahide Kondo	292456US0PCT	5965
22850 7590 10/16/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MARTINEZ, BRITTANY M				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
10/16/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/582,859

Applicant(s)

KONDO ET AL.

Examiner

BRITTANY M. MARTINEZ

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/30/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

Applicant's arguments/remarks and amendments filed on September 30, 2008, have been carefully considered. **Claims 1-5** are pending in the instant application. Upon further consideration of the restriction requirement made August 22, 2007, the restriction requirement has been withdrawn. **Claims 1-5** have been examined.

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. **Claims 4-5** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kondo et al. (WO 02/076611).
4. With regard to **Claim 4**, Kondo discloses a catalyst for use in producing an unsaturated aldehyde and an unsaturated carboxylic acid comprising at least molybdenum, bismuth, and iron (Kondo, "Abstract").
5. With regard to **Claim 5**, Kondo discloses a method for producing an unsaturated aldehyde and an unsaturated carboxylic acid by using a catalyst comprising at least molybdenum, bismuth, and iron, through gas-phase catalytic oxidation of propylene,

isobutylene, tertiary butyl alcohol or methyl tertiary butyl ether with molecular oxygen (Kondo, 0001).

6. With regard to **Claims 4-5**, the process for producing the composition is held to be obvious, when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983), and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir.1985). See also MPEP 2113.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 4-5** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 8, 10-11, and 19 of copending Application No. 10/473,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/473,255 discloses a catalyst for use in producing an unsaturated aldehyde and an unsaturated carboxylic acid comprising at least molybdenum, bismuth, and iron; and a method for producing an unsaturated aldehyde and an unsaturated carboxylic acid by using a catalyst comprising at least molybdenum, bismuth, and iron, through gas-phase catalytic oxidation of propylene, isobutylene, tertiary butyl alcohol or methyl tertiary butyl ether with molecular oxygen, substantially as in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. **Claims 4-5** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 14 of copending Application No. 10/504,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/504,143 discloses a catalyst for use in producing an unsaturated aldehyde and an unsaturated carboxylic acid comprising at least molybdenum, bismuth, and iron; and a method for producing an unsaturated aldehyde and an unsaturated carboxylic acid by using a catalyst comprising at least molybdenum, bismuth, and iron, through gas-phase catalytic oxidation of

propylene, isobutylene, tertiary butyl alcohol or methyl tertiary butyl ether with molecular oxygen, substantially as in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

10. **Claims 1-3** are allowed.

Response to Amendments

Applicant's amendments, filed September 30, 2008, with respect to the Specification and Title have been fully considered and are accepted. The objections to the Title and Specification, filed June 2, 2008, have been withdrawn.

Response to Arguments

11. Applicant's arguments filed September 30, 2008, with respect to the rejection of **Claims 1-3** under 35 U.S.C. 103(a) as obvious over Kondo et al. (WO 02/076611) have been fully considered and are persuasive. The rejection of **Claims 1-3** has been withdrawn.

12. Applicant's arguments filed September 30, 2008, with respect to the provisional rejection of **Claim 1** on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application Nos. 10/473,255 and 10/504,143

have been fully considered and are persuasive. The rejection of **Claim 1** has been withdrawn.

Conclusion

1. **Claims 1-3** are allowed.
2. In general, prior art renders the invention of **Claims 4-5** anticipated and obvious.
3. Applicant is required to provide pinpoint citation to the specification (i.e. page and paragraph number) to support any amendments to the claims in all subsequent communication with the examiner. **No new matter will be allowed.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRITTANY M. MARTINEZ whose telephone number is (571) 270-3586. The examiner can normally be reached Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached at (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wayne Langel/
Primary Examiner, Art Unit 1793

BMM

/Brittany M Martinez/
Examiner, Art Unit 1793